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| 09/491,841 | 08/23/1999 | Britta Daume | 6887 | 9106 |

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Shlesinger Arkwright & Garvey LLP
3000 South Eads Street
Arlington, VA 22202

EXAMINER

LUEBKE, RENEE S

| ART UNIT | PAPER NUMBER |
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2833

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 29

Application Number: 09/491,841
Filing Date: August 23, 1999
Appellant: DAUME

Michael M. Zadrozny
Shlesinger, Arkwright & Garvey LLP
For Appellant

MAILED
JAN 27 2004
GROUP 2800

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 28, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement indicating that there are no related appeals or interferences, which would directly affect or be directly affected by or have a bearing on the decision in the pending appeal, is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

| | | |
|---------|-----------|------------|
| 2279866 | Ellinwood | April 1942 |
| 2423627 | Tinnerman | July 1947 |

(10) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Rejection under 35 USC 112

Claims 1, 3, 7, 8, 11, 13, 14, 16-18, 20, 22-26, 29, 30 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention. Claims 1, 13 and 24 do not properly describe the invention as disclosed. Contrary to section (c) of claims 1 and 13, the band shaped contact element is not *attached* to the base. As noted on page 17 (see lines 16-21, in particular) and 18 of the specification, the base 4 **comprises** the band shaped contact element 10 and the elastic part 22. The band is a *part* of the base, not attached to it.

Rejection under 35 USC 102 - Ellinwood

Claims 1, 3, 7, 8, 11, 13, 14, 16-18, 20, 22, 24, 25, 29 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Ellinwood (US Patent 2,279,866). This device (see Figs. 5-8) comprises a base structure 10, 13 "adapted to be tensioned around a coaxial cable," sealing lips (the edges of cushion 13 that project - as in the area of reference numeral 13 in Fig. 7) "for providing a seal," and a band shaped, electrically conducting contact element 10 including a metallic contact protrusion 14.

Rejection under 35 USC 103 - Ellinwood

Claims 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellinwood. In regard to claim 23, Ellinwood discloses the use of a screw 12 to attach the brackets. The use of more than one screw is seen to have been an obvious duplication of parts. In regard to claim 26, Ellinwood discloses that the elastic part be formed of resilient rubber or other similar resilient and compressible material. One of average skill in the art would have concluded that a thermoplastic elastomer meets those requirements and would have seen such as an obvious alternative.

Rejection under 35 USC 103 - Ellinwood in view of Tinnerman

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellinwood in view of Tinnerman '627. Ellinwood is silent about how the screws are held to the bracket. However, Tinnerman teaches the use of a threaded bracket thereby reducing the number of required parts and securing the screw to the bracket prior to attachment. Therefore, it would have been obvious to use a threaded hole on the bracket of Ellinwood as taught by Tinnerman.

(11) Response to Arguments

Rejection under 35 USC 112

Claims 1, 3, 7, 8, 11, 13, 14, 16-18, 20, 22-26, 29, 30 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Appellant argues that the claim language is precise and refers to the figures of the elected species and other embodiments. However, appellant does not address the description of the device in the specification. It is there, on pages 17 and 18, where the base is defined as including the contact element.

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This is contradicted by the independent claims 1 and 13, which require that the contact element be attached to the base. The claims should not be read in a vacuum. After reading the specification, the claims become unclear. How can a part of device also be attached to the same device?

Even if the claims are read in a vacuum without considering the specification, claim 8 is contradictory. The elected embodiment (Figs. 5 and 6) does not comprise a conductive base structure (as required by claim 8) and a band shaped contact element attached to the base (required by claim 1 from which claim 8 depends)

Additionally, claims 24-26 confuse the relationship between the base, the band shaped contact element and the elastic part. The specification indicates that the base is comprised of an elastic part and a metal band (p. 17-18). Further, it indicates that the elastic part 22 has an outside surface 24 and an inside surface (not labeled) which "faces the body to be contacted." Where is the "surface coextensive with said base structure interior surface" as required by claim 24?

Rejection under 35 USC 102

Claims 1, 3, 7, 8, 11, 13, 14, 16-18, 20, 22, 24, 25, 29 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Ellinwood (US Patent 2,279,866). Appellant argues that the edges of cushion 13 that project (as in the area of reference numeral 13 in Fig. 7) do not provide the claimed sealing lips "for providing a seal." However, a seal is merely something that closes or fastens tightly or securely. As seen in the comparison of figs. 7 and 8, the member 13 is tight against structure A. It is therefore sealed. Although the present invention may be sealed to prevent entry of certain elements or by using particular materials as suggested in appellant's brief, these requirements are not found in the claims.

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In regard to claim 39, it is noted that the brackets 11 of Ellinwood are "provided with sealing surfaces" and are "adapted to sandwich an elastic sealing element therebetween" since they are flat surfaces which seal against one another. It is noted that no separate seal structure is positively claimed or required. Appellant states that the seal is positively recited in claim 1. However, claim 1 refers only to the sealing lips providing a seal between the base and a cable, not the sealing surfaces of claim 39, which are between the respective brackets.

Rejection under 35 USC 103 - Ellinwood

Claims 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellinwood.

In regard to claim 23, Ellinwood discloses the use of a screw 12 to attach the brackets. The use of more than one screw is seen to have been an obvious duplication of parts. Appellant argues that "obvious to try" does not establish prima facie obviousness. However, this is not a matter of "obvious to try." It has been held that mere duplication of the essential working parts of a device involves only routine skill in the art and is therefore obvious. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. One of average skill would duplicate a connection such as that of Ellinwood to guard against failure of the first connection, for example.

In regard to claim 26, Ellinwood discloses that the elastic part be formed of resilient rubber or other similar resilient and compressible material. One of average skill in the art would have concluded that a thermoplastic elastomer (TPE) meets those requirements and would have seen such as an obvious alternative. Appellant argues that one would not construct the cushioning of Ellinwood from an elastic TPE for the same reasons that TPE is used by the present invention. However, the device of Ellinwood requires the properties

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that are present in a TPE. This is the motivation to use a TPE for the device of Ellinwood – the needs and properties stated in the disclosure of Ellinwood.

Rejection under 35 USC 103 - Ellinwood in view of Tinnerman

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellinwood in view of Tinnerman '627. Ellinwood is silent about how the screws are held to the bracket. However, Tinnerman teaches the use of a threaded bracket thereby reducing the number of required parts and securing the screw to the bracket prior to attachment.

Appellant argues that there is no motivation to combine the references because “the modification to Ellinwood would not result in a device having less parts” and would instead render “the Ellinwood device more complex.” However, Ellinwood teaches no method of securing the screw to the bracket. In order to do this, one could use a nut or similar member (adding parts to the device) or one could make the bracket as taught by Tinnerman. Although slightly more complex, the bracket of Tinnerman allows the screw to be attached to one bracket end prior to final attachment. This enables an easier assembly and reduces the chances of loosing the screw.

Appellant further argues that the use of a bracket such as that of Tinnerman on the device of Ellinwood “destroys the intended function” of the bracket of Ellinwood “because it can no longer be attached to a supporting structure.” Appellant gives no support for this statement. The thread engager of Tinnerman would not prevent attachment to a support structure. Although it is not mentioned in the specification, it would have been expected that the bracket of Tinnerman be attached to something; if not, the electrical connection the bracket affords would be useless. In addition, the screw of Tinnerman is quite capable of extending through a support after engaging the bracket in the same manner that the screw of Ellinwood does this.

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(12) Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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rs1

January 14, 2004

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